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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,516	10/05/2005	Motoki Hiraoka	2886.0092-00000	5346
22852	7590	10/12/2007		
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER LAFOND, RONALD D	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 10/12/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/530,516	Applicant(s) HIRAOKA ET AL.	
	Examiner Ronald D. Lafond	Art Unit 1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>04/07/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Claim Objections***

1. Claims 1 and 5 are objected to because of the following informalities: Improper grammar and confusing language. The grammatical structure of these Claims as currently written is not correct, and the addition of the phrase 'an ozone solution-ultraviolet irradiation treating process' is confusing and unnecessary. Furthermore, the phrase 'in the state where' should be replaced with 'while.' Moreover, the transitional phrase 'characterized in,' while not technically improper in the current instance, is not the preferred transitional phrase in U.S. practice – the transitional phrase 'comprising' is synonymous and preferred. The Examiner recommends that Claim 1 be rewritten, for instance, as "A pretreatment method for an electroless plating material comprising irradiating a resin material with ultraviolet rays while said resin material is in contact with a [first] solution containing ozone," or some such equivalent (the bracketed term 'first' is unnecessary in these Claims, but need not be removed if Applicants so prefer). Claim 5 should similarly be rewritten. Appropriate correction is required.

2. Claim 2 is objected to because of the following informalities: Improper grammar. It appears that the word 'comprising' is missing between the words 'further' and 'carrying'. Appropriate correction is required.

3. Claim 9 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim has not been further treated on the merits.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1 – 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Honma, et al. (United States Patent 6,992,000 B2, hereafter Honma)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

6. Regarding Claim 1, Honma teaches a pretreatment method for an electroless plating material (see Column 1, lines 6 – 16, and Column 3, lines 22 – 26) characterized in that an ozone solution-ultraviolet irradiation treating process of irradiating a resin material in the state where said resin material is in contact with a first solution containing ozone is carried out (see Column 3, lines 27 – 32, and Column 7, lines 11 – 20).

7. Regarding Claims 2 and 3, Honma teaches the method further comprising carrying out an alkali treating process of bringing said resin material after said ozone solution-ultraviolet irradiation treating process into contact with a second solution containing an alkaline component and wherein said second solution further contains at least one of an anionic surface active agent and a nonionic surface active agent (see Column 3, lines 32 – 37, and Column 7, lines 22 – 27).

8. Regarding Claim 4, Honma teaches the method wherein said first solution contains one of an organic polar solvent and an inorganic polar solvent as a solvent (see Column 7, lines 53 – 62).

9. Regarding Claim 5, Honma teaches a method for producing a member having a plated coating (see again Column 1, lines 6 – 16), characterized in that the method includes a pretreatment method as in Claim 1 and an electroless plating process of subjecting said resin material after said ozone solution-ultraviolet irradiation pretreatment process to electroless plating (see Column 3, lines 22 – 26, and Column 8, lines 33 – 51).

10. Regarding Claims 6 and 7, Honma teaches the method further comprising an alkali treating process of bringing said resin material into contact with a second solution containing an alkaline component, between said ozone solution-ultraviolet irradiation treating process and said electroless

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plating process and wherein said second solution further contains at least one of an anionic surface active agent and a nonionic surface active agent (see again Column 7, lines 22 – 27).

11. Regarding Claim 8, Honma teaches the method wherein said first solution contains one of an organic polar solvent and an inorganic polar solvent as a solvent (see Column 7, lines 53 – 62).


Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D. Lafond whose telephone number is (571) 270-1878. The examiner can normally be reached on M - F, 9:30 AM - 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Cleveland can be reached on (571) 272-1418. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


RDL


FRED J. PARKER
PRIMARY EXAMINER